

### **REMARKS**

Claims 1-28 and 34-38 are now pending in the application. Claim 29 cancelled without prejudice. Withdrawn claims 30-33 were cancelled without prejudice. Claims 34-38 are new and are supported by the specification as originally filed. The amendments to the claims contained herein are of equivalent scope as originally filed and, thus, are not narrowing amendment. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

### **DRAWINGS**

The drawings stand objected under 37 CFR 1.83(a). The Examiner states that the compliant portion must be shown in FIGS. 53 and 54. Applicants respectfully submit that the compliant portion, identified at reference number 1512, is indicated in FIGS. 53 and 54. Reconsideration and withdrawal of the objection is respectfully requested.

### **SPECIFICATION**

Applicants have noted an informality in paragraph [0012] of the specification. Specifically, the last sentence of the paragraph was unfinished. The sentence was completed without adding new matter.

### **ALLOWABLE CLAIMS**

Applicants acknowledge with thanks the allowability of claims 19-25.

### **REJECTION UNDER 35 U.S.C. §101**

Claims 1-18 and 29 stand rejected under 35 U.S.C. § 5 U.S.C. § 101 as directed to non-statutory subject matter. This rejection is respectfully traversed.

Regarding independent claim 1, the Examiner states that the expression "first end fixedly retained in the bone" positively claims the bone. As the preamble makes clear, the claim is directed to a fixation device for attaching an external prosthesis to a bone. Reference to the bone does not constitute positively claiming the bone. Nevertheless, in the interests of clarity and to expedite allowance, Applicants have amended claim 1 to clarify that the bone is not claimed.

Claim 29 was cancelled without prejudice as to its subject matter.

Accordingly, reconsideration and withdrawal of the rejections of claims 1-18 is respectfully requested.

### **INFORMATION DISCLOSURE STATEMENT**

The Examiner states that the Information Disclosure Statement (IDS) filed 09/12/05 fails to comply with 37 CFR 1.98(a)(2), because it does not include a legible copy of reference DE 19931882 C1. Applicants included a copy of reference DE 19931882 C1 with the IDS mailed on 09/12/05 and the copy is shown in the image wrapper of the Private PAIR system of the USPTO.

The Examiner states that the Information Disclosure Statement (IDS) filed 09/12/05 fails to comply with 37 CFR 1.98(a)(2), because no concise explanation of relevance is provided. Applicants included a copy of the European Search Report of the counterpart European Patent Application No. EP 05251364.5 with the IDS mailed on

09/12/05 and the copy appears in the image wrapper of the Private PAIR system of the USPTO. Applicants submit that the European Search Report satisfies the requirement of concise explanation. MPEP §609.04(a), section III, 8<sup>th</sup> Edition, Revision 3, August 2005.

Applicants respectfully request consideration of the information provided in the Information Disclosure Statement (IDS) filed 09/12/05, and return of a marked copy indicating the Examiner's consideration.

#### **REJECTION UNDER 35 U.S.C. § 102**

Claims 1 and 26-29 stand rejected under 35 U.S.C. §102(b) as being anticipated by Justin (6,336,929). This rejection is respectfully traversed.

Regarding claim 1, which was amended for further clarity without limiting its scope, Justin appears to disclose an intermedullary distractor for use in a medullary cavity of a bone, which is not configured for receiving an external prosthesis. More specifically, Justin fails to disclose an extension configured for receiving an external prosthesis. Further, Justin fails to disclose that the main body and the extension define first and second engagement surfaces configured for constraining a bone graft between the first and second engagement surfaces.

Regarding independent claim 26, which was amended for further clarity without limiting its scope, Justin similarly fails to disclose a fixation device having first and second engagement surfaces configured for constraining the attached bone graft between the first and second engagement surfaces, wherein the fixation device is configured for receiving an external prosthesis at one end.

Claims 27 and 28 depend directly or indirectly from claim 26, and are, at least for this reason, not anticipated by Justin.

Claims 26-29 stand rejected under 35 U.S.C. §102(b) as being anticipated by Weissman et al. (5,871,540). This rejection is respectfully traversed.

Weissman et al. fails to disclose a compliant portion. At least for this reason, claims 26-28 are not anticipated by Weissman et al.

Claims 26-29 stand rejected under 35 U.S.C. §102(b) as being anticipated by Baccelli et al. (20003/0038249). This rejection is respectfully traversed.

Baccelli et al. fails to disclose a compliant portion. At least for this reason, claims 26-28 are not anticipated by Baccelli et al.

Reconsideration and withdrawal of the rejections of claims 1 and 26-28 is respectfully requested.

#### **NEW CLAIMS**

Claims 34-38 are new and are supported by the specification as originally filed. Claims 34-38 depend directly or indirectly from claim 26. Applicants respectfully submit that these claims are in condition for allowance.


#### **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is

believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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